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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,024	04/12/2004	Mitsuhiro Wada	02309/100H368-US1	3544
7278	7590	12/07/2005	EXAMINER	
DARBY & DARBY P.C.			HAND, MELANIE JO	
P. O. BOX 5257			ART UNIT	
NEW YORK, NY 10150-5257			PAPER NUMBER	

3761

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

TW

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/823,024		WADA, MITSUHIRO	
	<b>Examiner</b>		<b>Art Unit</b>	
	Melanie J. Hand		3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/12/04</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on July 2, 1999. It is noted, however, that applicant has not filed a certified copy of the JP 11-189196 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on April 12, 2004 was filed on the mailing date of the Application. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Specification***

The disclosure is objected to because of the following informalities: Applicant must provide a first paragraph in the Specification referencing the claimed priority status and the application number upon which said claim is based.

Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4-7 of prior U.S. Patent No. 6,719,743. This is a double patenting rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jessup et al (U.S. Patent No. 6,039,716) in view of Mitchell et al (U.S. Patent No. 5,637,106) and further in view of Osborn, III et al (U.S. Patent No. 5,885,265).

With respect to **Claims 1,5**: Jessup teaches flat absorbent member 12 that is rolled and then compressed into an "M-shaped" pledget 50 (Figs. 7,8,10,12) for use as a tampon. Ribbon 12 in

the rolled state forms elongated absorbent 14 that is then completely covered by liquid-permeable cover 16. (Figs. 1,3,5) ('716, Col. 3, lines 55,56, Col. 5, lines 10,20-22) Cover 16 is formed from a nonwoven apertured film wherein said film, and thus also said apertures, has a three-dimensional thickness. ('716, Col. 5, lines 48-50).

Jessup does not teach that said apertures penetrate the surface of the absorbent material 12. Mitchell teaches an absorbent insert that comprises a topsheet and backsheet and absorbent core, and that said insert material, in its flat unrolled state is subject to embossing to produce transfer sites through which liquid is transferred away from the user. ('106, Abstract) Mitchell teaches that said embossing results in the creation of channels 34 of higher fiber density that are interconnected and form a network providing excellent wicking characteristics ('106, Col. 4, lines 29-38), therefore it would be obvious to one of ordinary skill in the art to modify the absorbent material 12 with cover 16 by subjecting said material to embossing which would result in sites adjacent to said transfer sites wherein fibers would be compressed and entangled and thus have a higher fiber density as said transfer sites result in more rapid wicking of liquid away from the body surface of a wearer as taught by Mitchell.

The combined teaching of Jessup and Mitchell does not teach a depth, diameter or density for said three-dimensional apertures. With respect to diameter and density, Osborn teaches an interlabial absorbent article 20 with a cylindrical shape ('265, Col. 5, lines 26-28) having a topsheet 28 and backsheet 30 wherein topsheet 28 contains a plurality of apertures 50. Osborn teaches an aperture density of between 9-400/in<sup>2</sup> and an open area percentage of 30-40%. ('265, Col. 36-39, 46-48) Taking these teachings into account, the range for aperture diameter is 0.54-3.5 mm. Osborn is silent regarding the specific motivation for teaching aperture densities in said range, however Osborn teaches that article 20 is water-dispersable and flushable, and a higher density of apertures would hasten absorption and breakdown of the

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article in water and thus have a similar effect in terms of absorbing exudates more rapidly and transferring said exudates to absorbent core 32, therefore it would be obvious to one of ordinary skill in the art to modify the liquid-permeable apertured film cover 16 taught by Jessup to have an aperture density in the range taught by Osborn.

With respect to **Claim 4**: Jessup teaches that absorbent material 12 is comprised of rayon fibers. ('716, Col. 3, lines 64,65) Jessup also teaches that cover 16 is comprised of bonded carded nonwoven webs of polyester fibers ('716, Col. 5, lines 42-44), of which polyethylene terephthalate is one example.

Claims 2, 3, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jessup et al ('716) in view of Mitchell et al ('106).

With respect to **Claims 2,3,6,7**: Please see the rejection of Claim 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie J. Hand whose telephone number is 571-272-6464. The examiner can normally be reached on Mon-Thurs 8:00-5:30, alternate Fridays 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melanie J Hand  
Examiner  
Art Unit 3761

MJH

TATYANA ZALUKAEVA  
SUPERVISORY PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Tatyana', written over the printed name and title.